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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,965	06/14/2005	Scott Thomasq Milner	2003B133B	4339

23455 7590 01/11/2008  
EXXONMOBIL CHEMICAL COMPANY  
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EXAMINER
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RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/538,965	MILNER ET AL.	
	Examiner	Art Unit	
	Roberto Rábago	1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 12-14, 18, 19, 22, 24, 27, 28, 30, 34, 39, 46, 50-52, 54, 58, 62 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/19/07; 2/27/07; 6/14/05</u>                                | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1-3,7,8,12-14,18,19,22,24,27,28,30,34,39,46,50-52,54,58,62 and 66, and **70**.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, with election of species, in the reply filed on 10/19/2007 is acknowledged.

Following a search of the elected species, the remaining species are joined for examination.

### ***Claim Objections***

2. Claim 28 is objected to because the description of a halogenated hydrocarbon as a hydrocarbon is a contradiction in terms. By conventional organic nomenclature, a hydrocarbon consists only of hydrogen and carbon, and therefore a "hydrocarbon" may not include halogen. It would appear that the intended meaning is one where the claim should depend from claim 12, and "hydrocarbon is" should be changed to -- diluent further comprises --.

3. While not a point of objection or rejection, the following is noted with respect to the claim language. In reciting range endpoints for numerous claimed parameters, applicants have used the phrasing "from greater than" (e.g., claims 1, 3, 8). Normally, a range beginning with an endpoint indicated by "from" includes a second endpoint indicated by "to." However, in this case, the ranges are open-ended with no specific second endpoint, and therefore this phrasing is interpreted to have the same meaning

as if the word "from" were absent; i.e., "from greater than" is identical in scope to "greater than." Therefore, the word "from" adds no limitation or meaning to the scope of claimed open-ended ranges which specify only a single endpoint. If applicants disagree with this interpretation, they should either amend the claims to recite an alternative meaning, or explain the alternative meaning and identify support in the specification as filed.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 7, 8, 12-14, 18, 19, 22, 24, 27, 28, 30, 34, 39, 46, 50-52, 58, 62 and 66 are provisionally rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1,4-10,13-17,35,38,42-82,87-89 and 91-95 of copending Application No. 10/538,860. Although the conflicting claims are not identical, they are not patentably distinct from each other because a substantially overlapping scope of copolymers is being claimed. The claims in each application are essentially the same except that the copending claims require a copolymer sequence distribution parameter "m" while the instant claims require g'. However, the same methods which are described in the copending application to obtain a copolymer with the required values of "m" (i.e. the use of hydrofluorocarbons solvents), are described in this application to obtain a copolymer with the required values of g'. For example, Example 151 is noted, wherein a substantially identical example is disclosed in the copending application to obtain "m", while in the instant application obtains g'. Since the copolymer of the copending claims would inherently have the required g', the instant claims are not separately patentable because the copending claims anticipate the instant claims. The burden of proof is shifted to applicants to show that the claims of the copending application would not have the claimed value of g'.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 54 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 11/009,660. Although the conflicting claims are not identical, they are not patentably distinct from each other because a substantially overlapping scope of copolymers is

being claimed. The claims in each application are essentially the same except that the copending claims require a copolymer sequence distribution parameter "m" while the instant claims require  $g'$ . However, the same methods which are described in the copending application to obtain a copolymer with the required values of "m" (i.e. the use of hydrofluorocarbons solvents), are described in this application to obtain a copolymer with the required values of  $g'$ . For example, Example 151 is noted, wherein a substantially identical example is disclosed in the copending application to obtain "m", while in the instant application obtains  $g'$ . Since the copolymer of the copending claims would inherently have the required  $g'$ , the instant claims are not separately patentable because the copending claims anticipate the instant claims. The burden of proof is shifted to applicants to show that the claims of the copending application would not have the claimed value of  $g'$ .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

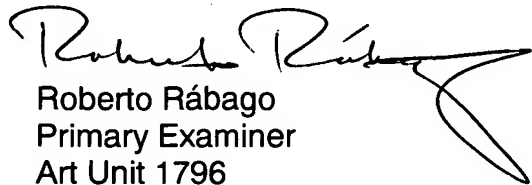
#### ***Information Disclosure Statement***

7. The information disclosure statement filed 2/27/2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the Matyjaszewski reference has not been considered because it consists of nothing but title and publication page.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Roberto Rábago  
Primary Examiner  
Art Unit 1796

December 23, 2007